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10/760,488	01/21/2004	Hiroyuki Suzuki	KAS-197	9791

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MATTINGLY, STANGER & MALUR, P.C.
1800 Diagonal Road, Suite 370
Alexandria, VA 22314

EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT	PAPER NUMBER
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1797

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12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/760,488	Applicant(s) SUZUKI ET AL.	
	Examiner P. Kathryn Wright	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2008 has been entered.

Status of the Claims

2. This action is in response to papers filed October 10, 2008 in which claims 9, 11, and 14-22 were amended. The amendments have been thoroughly reviewed and entered. Any objection/rejection not repeated herein has been withdrawn by the Examiner.

Claims 9-22 are under prosecution.

Information Disclosure Statement

3. The information disclosure statement filed July 11, 2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information submitted that is not in the English language. Applicant has included a copy of a non-patent literature document which is not listed on the IDS. This document is not in the English language. It has been placed

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in the application file, but the information referred to therein has not been considered.

The Examiner hereby requests a full translation of this document for consideration.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “one conveyor line” in claim 9, the “first and second rack rotors having a structure including the line switching unit” and rack rotors holding “a plurality of racks arranged so they lie side by side” claims 19-22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9 now recites "at least one or more conveyor lines". A single conveyor line is not supported in the original specification or shown in the Figures. This is considered new matter.

Claims 19-22 now recite the first and second rack rotors having a structure including the line switching unit. The original specification does not support an embodiment of the rack rotor which includes a line switching unit. The specification does describe the second rotor being replaced with a box-shaped unit 31 having a plurality of independent lines for holding the racks (see penultimate paragraph of page 16 and Figs 7-8). That is, the box-shaped unit has a line switching unit 11; however, none of the embodiments of rack rotors include the line switching unit.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 now recites "a conveyor unit for conveying sample racks...along at least one conveyor line". First is it not clear what the structural relationship is between the conveyor unit and the at least one conveyor line. The Examiner recommends Applicant recite "a conveyor unit comprising at least two or more conveyor lines", since a single conveyor line is not supported in the original specification or shown in the Figures, as discussed above.

Secondly, the last paragraph of claim 9 recites "conveyor lines" of the conveyor unit. This lacks antecedent basis since the claim recites at least one conveyor line. Thus, the limitation to the plurality of conveyor lines is unclear.

Claim 9 also recites "a first rack rotor and a second rack rotor comprising at least two buffers including a first buffer disposed at one end of said conveyor unit for receiving samples...and a second buffer disposed at the other end of the conveyor unit". This language is indefinite. It is not unclear whether Applicant intends for the first rack rotor and second rack rotor to include two buffers. It is also not clear as to how the "first buffer" differs from the "first rack rotor" or the "second buffer" differs from the "second rack rotor". The specification describes one embodiment of the first buffer (or reanalysis buffer) being a rack rotor 7, see page 7, line 9 from the bottom. Similarly, the second

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rack rotor 12 corresponds to the second buffer unit. Thus, it appears that Applicant is reciting the same limitation under different names. The recitation of the same element under different names in different parts of the claim or the use of same term to refer to different elements is indefinite. The same term should be used for an element each and every time it is recited. The Examiner recommends Applicant remove all recitations to the buffer units for clarity.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9, 11-14, 16-19, and 21, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Devlin, SR. et al., (US Patent Pub. No. 2003/0202905), hereinafter “Devlin”.

Devlin teaches an automatic analyzer comprising:

an analytical module 66 in analyzers 10, 11 for analyzing living body samples;

a sample loading unit 70 for supplying the samples;

a sample collection unit 76 for collecting the samples;

a conveyer unit 68 for conveying sample racks 42 with samples to be analyzed from the sample loading unit along at least one conveyor line to the analytical module

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and conveying sample racks, for which sampling has completed, from the analytical module to the sample collection unit;

a first rack rotor (70, 82 on analyzer 10 in embodiments of Figs. 5 and 6) and a second rack rotor (41, 82 on analyzer 11 in embodiments Figs. 5 and 6). The rotors are arranged on opposite sides of the conveyer unit 68.

Please note that functional recitations which describe the operation of conveyor and the rotor units have not received patentable weight. Only structural language is determinative of the metes and bounds of an apparatus claim. However, the first rotor rack does receive samples from the sample loading unit, hold them, supply desired ones of them to the analytical module 10 or 11, receive samples returned from the analytical module and supply returned samples to the sample collection unit 76. Likewise, the second rack rotor disposed at the other end of the conveyer unit holds samples for which sampling has completed, returns samples to be re-analyzed to the analytical module 10 or 11, and returns samples to be re-analyzed to the sample collection unit.

Devlin also teaches line switching units 72, 74 for switching the conveyer line of the conveyer unit 68 to transfer samples for which sampling has been completed to the second rack rotor for them to wait for analysis results, and to remove samples still to be subjected to sampling to the first rack rotor if another sample requires urgent analysis, the first rack rotor being adapted to supply the sample requiring urgent analysis to the analytical module via the conveyer unit from which samples have been evacuated, see entire document, especially paragraph [0037] et seq.

Regarding claim 11, Devlin teaches the conveyer unit has one conveyer line 68 that is moved back and forth (i.e., bidirectional), see entire document, especially paragraph [0044].

As to claim 12, Devlin teaches conveyer unit has at least two conveyer lines 85, 93 that are moved back and forth by bi-directional motors 88, 94, respectively (see for example paragraphs [0029]-[0030]).

Regarding claim 13, Devlin teaches at least two conveyer lines 85, 93 of which one is dedicated to forward movement and another is dedicated to backward movement when so instructed by controller 15 (see paragraph [0030]).

With respect to claims 14, 16-18, Devlin teaches an embodiment of the first and second rotor 82 in which each have a structure in which the plurality of racks are held substantially along spokes of a rotatable base 82 (see embodiment of Fig 6).

Regarding claims 19, 21 and 22, Devlin teaches an embodiment in which first rack rotor and second rack rotor 41, 70 each have a structure holding a plurality of sample racks arranged on a base so that they lie side by side (i.e., end to end) substantially in one direction (see embodiment Fig. 5); the structure includes the line switching unit 74 for moving the base in a direction substantially perpendicular to the direction in which sample racks are arranged.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 10, 15, and 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Devlin in view of Takahashi et al. (US Patent No. 6,290,907), hereinafter "Takahashi".

Devlin teaches the invention substantially as claimed except for the urgent sample loading unit for receiving an urgent sample and conveying to the first rotor (i.e., first buffer).

Takahashi teaches an automatic analyzer system comprising a plurality of

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analytical modules 3, 5-9 for analyzing a living body sample. Takahashi teaches sample buffer arrangement comprising a plurality of buffers 2a,b, 13, 14 capable of holding a plurality of sample containers containing samples and supplying desired ones of the sample containers held on the sample buffer to the conveyer unit, and receiving the sample containers returned from the analytical module through the conveyer unit. The buffers 2a, b and 14 are disposed on ends of conveyor units (see Fig. 1). Takahashi also teaches a sample loading unit 11a,11b for supplying urgent samples to the sample buffer and an urgent sample loading unit 12 for supplying urgent samples to the sample buffer, and sample collection unit 60 for collecting samples from the sample buffer (see col. 8, lines 37+).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the analyzer system of Devlin the urgent sample loading unit of Takahashi since this will provide for the immediate analysis of an emergency sample.

As to claim 15, Devlin teaches an embodiment of the first and second rotor in which each have a structure in which the plurality of racks are held substantially along spokes of a rotatable base 82 (see embodiment of Fig 6).

Regarding claim 20, Devlin teaches an embodiment in which first rack rotor and second rack rotor 41, 70 each have a structure holding a plurality of sample racks arranged on a base so that they lie side by side (i.e., end to end) substantially in one direction (see embodiment of Fig. 5); the structure includes the line switching unit 74 for

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moving the base in a direction substantially perpendicular to the direction in which sample racks are arranged.

Response to Arguments

15. Applicant's arguments with respect to claims 9-22 have been considered but are moot in view of the new ground(s) of rejection as set forth above.

Conclusion

16. No claims allowed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/
Examiner, Art Unit 1797